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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,373	09/28/2001	Keegan F. O'Neill	VIP-101	2261
21272	7590	03/14/2006	EXAMINER	
MORLAND C FISCHER 2030 MAIN ST SUITE 1050 IRVINE, CA 92614			PYZOCHA, MICHAEL J	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/964,373	Applicant(s) O'NEILL ET AL.	
	Examiner Michael Pyzocha	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-6 are pending.
2. Amendment filed 02/27/2006 has been received and considered.

Drawings

3. The drawings were received on 02/23/2006. These drawings are acceptable.

Specification

The objections to the specification and title have been withdrawn based on the filed amendment.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Architecture for Password Reset Questions" (hereinafter IU) in view of Angelo et al (US 6581162).

As per claim 1, IU discloses a method for enabling an original password to be reset on a host computer from a remote workstation by an authorized user without logging onto the host computer, said method comprising the steps of: storing on said host computer a user registration profile including personal information selected by the authorized user; connecting said remote workstation to said host computer; interrogating the authorized user for the personal information stored on said host computer as said user registration profile; comparing the personal information provided by the authorized user with the personal information stored on said host computer; sending a new user password from said remote workstation to said host computer, provided that the personal information provided by the information that is stored on said host computer; and authorized user matches the personal resetting the original password on the host computer with said new user password (see page 1).

IU fails to disclose capturing the identity of said remote workstation by said host computer.

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However, Angelo et al teaches capturing the identity of said remote workstation by said host computer (see column 6 lines 40-52).

At the time of the invention it would have been obvious to a person of ordinary skill in the art for IU's password changing system to capture Angelo et al's workstation identity.

Motivation to do so would have been to allow a network server to identify a particular network node and grant access privileges accordingly.

As per claim 2, the modified IU and Angelo et al system discloses picking questions and the corresponding answers to be stored on the host computer as the personal information that forms said user registration profile (see IU page 1).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified IU and Angelo et al system as applied to claim 1 above, and further in view of Schneier (Applied Cryptography).

As per claim 3, the modified IU and Angelo et al system fails to disclose encrypting the registration profile and storing the encrypted user registration profile at a secure location of the host computer.

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However, Schneier teaches these security features (see pages 220-223).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Schneier's encryption and storage in the modified password system of IU and Angelo et al.

Motivation to do so would have been to secure the information.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified IU and Angelo et al system as applied to claim 1 above, and further in view of Gong (US 6192476).

As per claim 4, the modified IU and Angelo et al system fails to disclose the use of a computer program to change the password.

However, Gong teaches this limitation (see column 13 lines 12-21).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Gong's computer program for resetting the password in the modified IU and Angelo et al system.

Motivation to do so would have been to only allow code from specific sources to reset the password.

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8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified IU, Angelo et al, and Gong system as applied to claim 4 above, and further in view of Schneier.

As per claim 5, the modified IU, Angelo et al, and Gong system fails to disclose deleting the program after its use.

However, Schneier teaches deleting private information (see pages 184-185).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Schneier's method of deleting private information to delete the password program of the modified IU, Angelo et al, and Gong system.

Motivation to do so would have been that in a computer system information can be easily copied.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified IU and Angelo et al system as applied to claim 1 above, and further in view of Jacobs et al (US 5611048).

As per claim 6, the modified IU and Angelo et al system fails to disclose the use of a predetermined account name allowed to reset passwords.

However, Jacobs et al teaches the use of only allowing specific user(s) to change the password (see column 2 lines 8-33).

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At the time of the invention it would have been obvious to a person of ordinary skill in the art to only Jacobs et al's specific user(s) to change the password in the modified IU and Angelo et al system.

Motivation to do so would have been update remote system's passwords, which the user has access.

Response to Arguments

10. The declaration under 37 CFR 1.131 filed February 23, 2006 is insufficient to overcome the rejection of claims 1-6 over "Architecture for Password Reset Questions" (hereinafter IU) in view of Angelo et al under 35 USC § 103(a) as set forth in the last Office action 06/20/2005 because it is not properly executed and fails to establish reduction to practice prior to the date of the UI reference.

I. Formalities:

The affidavit is ineffective because it was not properly executed. It was not signed by all inventors:

(A) All the inventors of the subject matter claimed.

(B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted

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where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.

(C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.

(D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. Ex parte Foster, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903).

Applicant has not met any of the criteria above.

Therefore, the affidavit is ineffective on its face and Applicant has not shown prior invention and the rejection is maintained. However, in the interest of expediting prosecution, the Examiner will provide some guidance as to perceived deficiencies in the submitted declaration. These comments are not meant to be comprehensive.

II. General considerations from MPEP 715.07:

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."

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In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." In re Asahi/America Inc., 68 F.3d 442, 37 USPQ2d 1204, 1206 (Fed. Cir. 1995) (Citing Newkirk v. Lulejian, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir. 1987) and Sachs v. Wadsworth, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.).

III. Reduction to Practice:

Applicant attempts to establish prior invention by showing Reduction to Practice of the invention prior to the May 10, 2001, the effective filing date of UI.

Something that falls within the scope of the claimed invention must be shown to be reduced to practice.

Insofar as applicant may be relying on the PowerPoint presentation and the user's guide (and the e-mail) to establish Reduction to Practice, the Examiner notes that a written description does not constitute an actual Reduction to Practice. Furthermore, only the filing of a US patent application, which complies with the disclosure requirement of 35 USC § 112 constitutes a constructive reduction to practice. A written

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description, no matter how complete, does not qualify as an actual reduction to practice.

Proof of actual reduction to Practice requires a showing that the apparatus actually existed and worked for its intended purpose or that a method was actually practiced.

For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853, 860, 226 USPQ 402, 407 (Fed. Cir. 1985).

In paragraph 2-6 of the affidavit applicant refers to a PowerPoint presentation, a user's guide and an e-mail written prior to the critical date which applicant alleges amounts to a reduction to practice of the invention. In particular paragraph 5 states: "I conceived the method...on a date earlier than May 10, 2001" and paragraph 6 states: "The remote desktop interface to which this patent application relates was completed and sent to a customer for testing in early 2001, but prior to May 10, 2001." These statements amounts to mere pleading, there is no clear explanation of how the exhibits establish conception and/or reduction to practice of the claimed invention.

The Examiner has reviewed the exhibits and they appear to be sufficiently detailed that they may be adequate to support

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conception of the claimed invention given a properly executed and constructed declaration.

However, since the supplied declaration is not proper and therefore the Applicant has not established prior invention. The rejection is maintained.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner

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can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER